

Appl. No.: 09/932,664
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Off. Act. Dated: 06/21/2005

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. Rejection of Claims 1-45 under 35 U.S.C. § 103(a).

Claims 1-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Janik et al. (U.S. Pat. Application No. 2003/0005433) in view of Engstrom (U.S. Pat. Application No. 2004/0171377).

(a) Claims 1, 15, 28, 33, 39 and 45. Claims 1, 15, 28, 33, 39 and 45 are the independent claims in this application. Each of said claims recites a data marking system or method.

After carefully considering the grounds for rejection, the Applicant responds as follows.

The claim rejections suffer from a number of shortcomings with regard to the Janik and Engstrom references. In addition, the amendments to the claims further clarify and focus the material providing even further distinction from the relied-upon references.

Considering first the rejection of the claims prior to the current amendments, it should be noted that the Janik reference describes a data marking device which registers frequency of the station listened to. In this way it differs from the instant application, as it uses a tuner for determining the selected radio station.

In order to overcome that shortfall, the Examiner combines Janik with Engstrom. However, the teachings of the Engstrom reference are mischaracterized as being a data marking device which executes marks independent of frequency. In particular, the Examiner states that *"Engstrom teaches 'wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time' as the playlist information could include advance information about the content of a stations schedule, such as song title, artist, estimated broadcast time and data (see paragraph 61)."*

However, from close examination of the Engstrom reference it is clear that

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Engstrom does not describe a data marking device at all. Instead, the teachings of Engstrom are directed to “*a method, system and apparatus for finding, playing, and recording broadcasts on a mobile device (400) that includes two or more tuners, and also works as a cellular telephone*” as found in the first line of the ABSTRACT.

Engstrom is certainly not independent of frequency, in fact it suggests more dependency on frequency as it has two tuners. In addition, Engstrom does NOT mark items at the time of broadcast so as to later gather information about them, but instead provides a second tuner to allow recording on one tuner while playing from another. The only searching by Engstrom is that of the user searching to select that which they desire to play or to record.

DIFFERENT OBJECTS AND OPERATING PRINCIPLES

In view of the above discussion of the references, it is clear that Engstrom and Janik are drawn to different objects of invention as well as different operating principles. Please refer to the following portions of the MPEP in this regard:

MPEP 2143.01A: “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” Emphasis added.

MPEP 2143.01A:

“THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)”

Both the objects and operating principles differ between the references, wherein they cannot properly be combined.

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NO NEED FOR ELEMENT IN REFERENCE

In addition, how is there a motivation or suggestion if the reference has no need, or would not benefit from the combination? In this case the Engstrom reference describes the ability to record the content. If the user is recording what is being played, and thus creating a copy as it is being played: how is it they have a need to also save a time mark so they can later find information about the content to allow them to get a copy of it. There is no need of the elements of the combination.

SUGGESTION OR MOTIVATION IS FROM APPLICANT TEACHING

In providing evidence of suggestion or motivation for the combination, the rejection only states that it is *“to provide a marked data indicates a time and said marked data represents content that is broadcasted at said time and the search request is independent of frequency corresponding to said content that is broadcasted as disclosed by Engstrom’s system. This would allow Janik’s system to find, play, and record broadcasts based on user preferences in order to reduce wastes considerable time finding a suitable broadcast as suggested by Engstrom (see page 1, paragraph 0004, last six lines)”*.

A number of problems arise with regard to the correctness and propriety of the above assertions.

First, Engstrom does not teach a data marking device. It teaches a device for playing or recording broadcast content. As mentioned above there is no need for the combination.

Second, the stated intent of the combination is given as allowing *“Janik’s system to find, play and record broadcasts”*; however, neither Janik or the claims of the instant application are directed toward finding broadcast content, or playing broadcast content, or the recording of broadcast content.

Third, the wording of the support for the combination provides no specific details as to how the combination would need to be implemented.

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Fourth, the section of Engstrom relied upon by the Examiner (paragraph [0004]) describes only the benefits of adding a broadcast tuner and recording means to the cellular phone, as otherwise *"a user often wastes considerable time finding a suitable broadcast"*. The conclusion being in the next line that *"...there exists a need for integrating some of these features into a mobile device such as a cellular telephone"*. However, that has nothing to do with the claims of the instant application.

Fifth, there is no support given from the references themselves which provide suggestion, motivation, or incentive for making the combination. Please refer to the following section of the MPEP in this regard:

MPEP 2143.01 Suggestion or Motivation To Modify the References [R-1]

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). **The level of skill in the art cannot be relied upon to provide the suggestion to combine references.** Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

The instant application is drawn to a system and method of finding music and more specifically the identifying, locating and sharing of bookmarked music clips (see title, field of invention, page 3 lines 16-25). The current amendments further clarify and refine the claim language to bring out these aspects. Although the claim amendments were not introduced to overcome the references, the Applicant contends that the above arguments alone overcome the combination of references, the claim amendments do as a matter of course extend the differentiation from the teaching of those references as brought out in further detail below.

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The amended independent system claims are focused on the server side of the system, with additional elements being described to clarify the relationship and understanding of the other elements.

The user playlists are accessible by the server from a database. The playlists contain information about music clips which were previously broadcast, as the playlist is searched after the song is marked. Nothing of this nature is found in the references. (It should be noted that the playlist could be generated by a broadcast site at any time before or after broadcast as long as it or a copy of it is available in the broadcast playlist database.)

The network interface from the server communicates with a user terminal, ostensibly the terminal from which a search is being initiated. The search request corresponds to a marked data, or information about the marked data. It will be appreciated that either the marked data can be selected, or the information which the user has collected about the marked data, as the base for the search.

The programming of the server computer is then described to access, search and transmit a result.

Independent system Claim 15 includes an additional limitation regarding the inclusion of a broadcast playlist database as accessed by the server for retrieving the information about music clips that have already been broadcast. Although this aspect is not needed within the search for new content itself, the conversion of the data marks to music clip information requires access to this database.

Independent system Claim 28 includes an additional limitation regarding the nature of the marked data.

Independent system Claim 45 is similar to Claim 1, but written in a means plus function format.

The amended method Claims 33 and 39 provide additional clarity to the inventive aspects sought. In Claim 33 the "utilization" of the marked data is further explained with regard to the search. Claim 39 adds additional limitation to that of Claim 33, in that the

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retrieval and display of the additional playlist information is described.

It should be recognized that none of the aspects described above with regard to amended system and method claims can be equated to the cited references, either singly or in combination thereof.

Accordingly, there is no support for the rejection of the independent claims, whether unamended, or in the currently amended versions.

(b) Claims 2-14, 16-27, 29-32, 34-38, and 40-44. .

Dependent Claims 2-14, 16-27, 29-32, 34-38, and 40-44 are based on independent claims which have been shown to be patentable over the cited references, wherein these dependent claims should be considered *a fortiori* allowable.

Furthermore, the material from a number of the dependent claims has been misapplied in relation to the cited references. The following is provided by way of example on only of couple of these instances.

Claim 5. Dependent Claim 5 describes an aspect of searching for additional music clips based on one that is already collected. The aspect described is the inclusion of an indicator to show that the marked data, or information about the marked data, has been selected for search.

In support of the rejection, a section of Janik is recited (Paragraph [0003]) which describes looking up the data mark to gather the music clip information about that specific data mark. It does not describe whatsoever the search process recited in the base claim as extended in dependent Claim 5.

Claim 7. Dependent Claim 7 describes the iconic representation of the marked data under a search request as including a hypertext link.

In support of the rejection a section of Janik (Paragraph [0022]) is relied upon. The entire text of section [0022] is as follows: "*HTTP is Hyper-text transfer protocol, the protocol used by Web browsers and Web servers to transfer files, such as text and graphic files.*"

From the above it can be clearly seen that Janik provide no recitation of this

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element. It should further be realized that merely a recitation of the use of a hyperlink would not comport to the combination description of the hyperlink used for this specific purpose.

Other dependent claims have similarly been miscast toward elements within the relied-upon reference although they do not comport to the teachings therein.

Accordingly, the dependent claims should be considered allowable.

Therefore, the rejection of independent Claims 1, 15, 28, 33, 39 and 45 lacks support, and the rejection of those claims and the claims that depend therefrom should be withdrawn.

2. Amendments of Claims 1, 3, 5, 9-11, 14-15, 17-18, 22-24, 28-31, 33-34, 37-43 and 45.

The following claims were amended to clarify and to further focus the claims of the invention. The support for these amendments is given below.

Claims 1, 15, 28 and 45. Independent system Claims 1, 15, 28 and 45 were amended to recite a number of additional aspects.

The use of a server computer is described for communicating over a data network as described in the specification including page 2, lines 16-17.

The user database comprising user information and user playlists are described in the specification including page 1, line 17 through page 2, line 7; FIG. 8 elements 860 - 863; FIG. 9-11; FIG. 13 element 1330; page 12, lines 10-20; and so forth.

The network interface of the server is described in the specification including element 840 in FIG. 8 as well as page 11, lines 27-30; and so forth.

The equivalence of the marked data or information about the marked data is described with regard to the bookmarked music clips in the specification including page 18, lines 12-17 and 24-28, as well as other places.

The programming of the server is recited, a server being a computer based network-enabled device it of course operates in response to programming, which is also described in the specification such as at page 12, lines 21-27.

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Accessing, searching and transmitting a result are described in the specification including page 16, lines 15-18; page 17, lines 10-15 and 20-25; page 18, line 5, 11-13, 24-28; page 19, lines 5-15, and so forth.

The result including data marks or associated music clip information "*broadcast over one or more radio stations*" was found in original Claim 14, now amended.

Independent system Claim 15 includes an additional limitation regarding the nature of the music clips whose information is accessed by the server on a broadcast playlist database as described in the specification including FIG. 8 element 862, page 5, lines 13-24; page 12, lines 16-19; page 19, lines 10-19, and so forth.

Independent system Claim 28 includes an additional limitation regarding the nature of the marked data, specifically the phrase "*wherein said marked data indicates a time and which represents content that is broadcasted at said time*" is retained from the original Claim 28.

Independent system Claim 45 is similar to Claim 1, but written in a means plus function format. The means terms have been redirected in similar manner as the construction of the non-means elements in amended Claim 1.

Claims 33 and 39. Independent method Claims 33 and 39 have been amended to recite with greater clarity the "utilization" of the marked data in the search. Support is found in the specification including page 16, line 10 through page 17, line 9 and so forth. Claim 39 adds the additional limitation regarding the retrieval and display of the additional playlist information, support for which is found in the specification such as at page 3, lines 4-6 and 16-25; FIG. 12; page 16, lines 25-29, and so forth.

Claim 3. Dependent Claim 3 was amended to follow the server-centric organization of Claim 1, wherein the reference to the user terminal was recast onto its relation to the server.

Claim 5. Dependent Claim 5 was amended to clarify that it is the marked data, "*or information about the marked data, with a search command*"; which now ties in with Claim 1 wherein this aspect was already described.

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Claims 9 and 22. Dependent Claims 9 and 22 were amended to properly recite that the programming on the server outputs the search request in progress display, although upon receipt of this the user terminal outputs an indication of search progress. Support is found in the specification including page 16, lines 14-29 and so forth.

Claims 10, 23, 29 and 37. Dependent Claim 10 was amended to remove the reference to user playlist database, which has been incorporated into the independent base claim, and to recite specific conditions of the search. Support is found in the specification including page 17, lines 23-30, and so forth.

Claims 11 and 24. Dependent Claims 11 and 24 were amended to further recite that the user playlists contain information about music clips which have been broadcast, as was in original claim 14; page 5, lines 14-27; and so forth.

Claim 14. Dependent Claim 14 was amended to remove the reference to the transmitting of the result, which has been incorporated into the independent base claim, and to further recite the broadcast database. This aspect is already incorporated within independent Claim 15 as described above.

Claim 17. Dependent Claim 17 was amended to change "*said*" to "*the*" in reference to the user terminals and "*server terminal*" to just "*server*" both of which better follow the language of base claim 15.

Claim 18. Dependent Claim 18 was amended to recite how the marked data is selected with a search command, as described in the specification including page 16 line 15 through page 16 line 30.

Claim 30. Dependent Claim 30 was amended to replace "*one user terminal*" with programming executable on said server, which is more in line with amended Claim 28.

Claim 31. Dependent Claim 31 was amended to better match the language to the amended base claim.

Claim 34. Dependent Claim 32 was amended to remove the reference to the initiating step including selecting bookmarked music which is now incorporated in the base claim, and to specifically recite how searching of user playlists of a second or

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additional user is performed. Support for which is found in the specification including page 3, lines 16-25; page 17, lines 10-12 and 23-30; and so forth.

Claim 38. Dependent Claim 38 was amended to include in the alternative the material of preceding claim 37, specifically *"storing said received playlist"*.

Claim 40. Dependent Claim 40 was amended to remove the initiation operation description and to further describe the indication the search is in progress after the initiation of the search. Support for this aspect is found in the specification including page 16, line 30 through page 17 line 9, and so forth.

Claim 41. Dependent Claim 41 was amended to match the language of amended Claim 39.

Claim 42. Dependent Claim 42 was amended to remove the reference to the database which is incorporated in the base claim to describe the search condition as comprising a genre of music, support for which is found in the specification, such as at page 17, lines 27-30 and so forth.

Claim 43. Dependent Claim 43 was amended to remove the reference to the database updating, and to describe the search condition as comprising selecting one or more broadcast stations to be searched, support for which is found in the specification, such as at page 17, lines 27-30 and so forth.

3. Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, Applicant has made these amendments to clarify the claims and provide enhanced focus on the objects of the invention. However, Applicant does not acquiesce in the original ground for rejection with respect to the original form of these claims. These amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicant reserves the right to pursue the original scope of these claims in the future, such as through continuation practice for example.

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4. Request for Continued Examination (RCE).

An appropriate fee is enclosed for an RCE (Request for Continued Examination) of this application (See 37 CFR 1.114).

5. Conclusion.

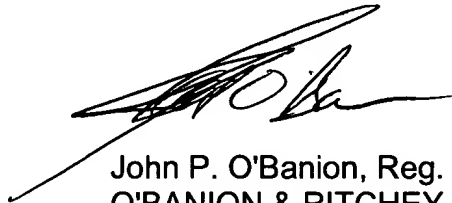
Based on the foregoing, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present application to pass to issuance.

In the event any further matters remain at issue with respect to the present application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: _____

9/20/05

Respectfully submitted,



John P. O'Banion, Reg. No. 33,201
O'BANION & RITCHEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
(916) 498-1010



CERTIFICATION UNDER 37 CFR 1.8

I hereby certify that the foregoing:

Amendment

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JOHN P. O'BANION

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